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In re Application of  
Schiele  
Application No. 10/550,166  
PCT No.: PCT/EP04/02971  
Int. Filing Date: 22 March 2004  
Priority Date: 21 March 2003  
Atty. Docket No.: KW-17PCT  
For: Coating Device For Water-Based Lacquer  
That Is Dried By Near-Infrared Light

DECISION

This is in response to the correspondence filed on 22 August 2006.

**BACKGROUND**

This international application was filed on 22 March 2004, claimed an earlier priority date of 21 March 2003, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 30 September 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 21 September 2005. Applicant filed, *inter alia*, the basic national fee on 20 September 2005.

On 08 May 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the filing of an oath or declaration compliant with 37 CFR 1.497(a) and (b), a surcharge under 37 CFR 1.492(h), a processing fee under 37 CFR 1.492(i), and an acceptable English translation of the international application (noting that "The number of claims in the international Application and the number of claims in the translation are not the same.").

On 26 June 2006, a Response was filed, including a declaration and the surcharge under 37 CFR 1.492(h).

On 10 August 2006, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicant, again requiring a processing fee under 37 CFR 1.492(i) and an acceptable English translation of the international application (again noting that "The number of claims in the International Application and the number of claims in the translation are not the same.").

**DISCUSSION**

Applicants request withdrawal of the Notification of Defective Response because

... applicant respectfully points out that the claims were amended during the international phase of the above-identified International Application. Specifically, during the international phase, original claims 1 - 6 were replaced by new claims 1 - 5. Accordingly, the submitted translation of the amended pages incorporated into the International Application is the correct translation of the claims of the International Application as amended. Furthermore, it is respectfully pointed out

that a translation of the original International Application with 1 - 6 has also been submitted in the present application.

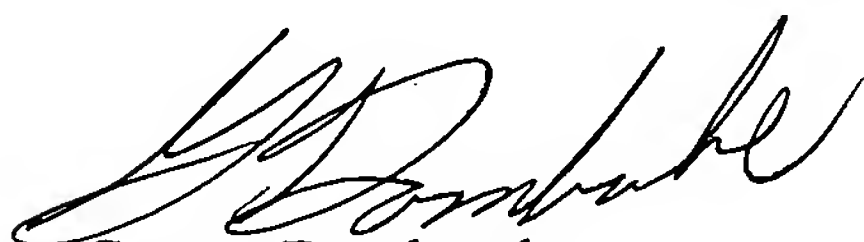
Review of the Image File Wrapper for this application reveals that the published international application (in the German language) includes 6 claims, while the translation filed on 20 September 2005 included 5 claims, as well as a marked-up copy of a set of 5 claims. No set of 6 claims, corresponding to the claim set present in the published international application, is currently of record in the application file. In the event that applicant believes that the absence of a 6-claim set is the result of error, submission of a copy of the 6-claim set and proof of its date of filing would be appropriate.

With regard to counsel's argument that the 5-claim set is the appropriate set of claims for the translation, counsel is advised that the translation of the international application referred to by 35 U.S.C. 371(c)(2) is a translation of the international application as filed (or as published), while the requirement to furnish translations of annexes to the international application arises separately, under 35 U.S.C. 371(c)(5). Since the published international application included 6 claims, while the translation only includes 5, the translation clearly is not a proper translation of the international application as filed (or published). Therefore, the translation does not satisfy the requirements of 35 U.S.C. 371(c)(2). As such, the mailing of both the Notification of Missing Requirements on 08 May 2006 and the Notification of Defective Response on 10 August 2006 was appropriate. Since applicants have not timely complied with the requirements set by those Notifications, this international application stands **ABANDONED** with respect to the national stage in the United States.

### **CONCLUSION**

The application is **ABANDONED**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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